

### REMARKS

Applicant hereby replies to the Office Action mailed on November 10, 2004, of which this reply is filed within the three month shortened statutory period for response. The application included claims 1-13, and 16-23 and the Examiner rejects these claims. Upon entry of the foregoing amendments, the application includes claims 1, 3-6, 10, 12-13, 16, 23 and new claims 24-28.

Applicant thanks the Examiner for the courtesies extended during the Examiner interview on January 18, 2005. As suggested by the Examiner, upon entry of the foregoing amendments, Applicant amends independent claims 1, 16, and 23 to include the limitations of active method steps that link the teaching activities to brain development and the development of future school skills. The Examiner also supported Applicant's suggestion to write an independent claim from the viewpoint of the manufacturer (instead of the user). Also, per the interview, Applicant clarifies how the activity cards are linked to the particular activity items and to brain building of future school skills. As also discussed with the Examiner, in addition to the numerous amendments, Applicant includes affidavits of commercial success to help prove a nexus between the novelty of the present invention and its commercial success.

#### Claim Objections

The Examiner objected to Claim 23 and requested clarification of the claim language. Because Applicant amended Claim 23, Applicant asserts that the objection is now moot.

#### §112 Claim Rejections

The Examiner rejects claims 1-13 and 23 under 35 USC 112. Regarding Claim 1, the Examiner claims that there is not disclosure of a housing including at least one different item related to each area of brain development. Applicant respectfully disagrees and directs the Examiner to, for example, paragraph 0025, where the application discloses that:

each of the activity items 104 is selected for inclusion in system 100 based upon its effectiveness in illustrating a particular concept to a caregiver. In another embodiment, an activity item 104 may be selected for inclusion in system 100 because it can assist a caregiver in understanding why a particular activity benefits a child's brain development. (emphasis added)

Regarding Claim 23, the Examiner asserts that the specification does not disclose "a plurality of databases." Applicant respectfully disagrees and asserts that one skilled in the art would know that a database may include a plurality of sub-databases. However, to expedite prosecution of this application, Applicant deletes this element from the claims. As such, this rejection is now moot.

The examiner rejects Claims 16-22 under 35 U.S.C. 112 as being indefinite. Applicant traverses this rejection, but because Applicant has amended Claim 16, Applicant asserts that the objection is now moot.

### **§103 Claim Rejections**

The Examiner next rejects claims 1-13, and 16 under 35 USC 103(a) as being unpatentable over "Brilliant Beginnings Baby Brain Basics Birth to 12 months Parent Kit" in view of Werzberger '298. Applicant respectfully traverses these rejections. As suggested by the Examiner, upon entry of the foregoing amendments, Applicant amends independent claim 1 to clarify that each activity item is analyzed to determine how the activity item stimulates a predetermined stage of brain development to create a brain link. Applicant also clarifies independent claim 1 to include a step of determining how a predetermined stage of brain development promotes early development of future school skills in a child to create a school link. As stated by the Examiner, Brilliant Beginnings does not disclose or suggest a complete method for "creating an activity card related to said activity item, said activity card having a first area that identifies said brain link and a second area that identifies said school link." As discussed, the claim does not simply relate to printed matter; rather, the claim encompasses numerous active steps from the manufacturer point of view.

The specification adequately supports a brain link and school link. For example, the specification includes at paragraph 0031: "Activity card 200 may indicate any or all of the following: . . . a brain link 216 for the activity (*e.g.*, a description of why the activity promotes brain development, including a description of the area of the brain that is stimulated by the activity), and a school link 218 for the activity (*e.g.*, a description of how development of the targeted capabilities may assist a child in preparing for formal education, such as attending school for example)."

Applicant asserts that the activity cards, which include the linkage between each of the different items in the housing to the brain development and the future school skills, are critical to

the claimed invention. Unlike existing toy boxes or instructions on how to use toys, the presently claimed invention indicates how the item is related to brain development and future school skills, which is a major motivator to caregivers to implement certain activities. Moreover, the brain development and future school skills provides scientific support for each activity such that the caregiver can justify the activities, instead of simply thinking of the activities as fun "games" to merely occupy time. Furthermore, caregivers looking to focus on certain school skills or certain areas of the brain will be aware of the particular activities to focus on. Thus, Applicant asserts that, in light of its amendments to independent claims 1 and 16 as well as dependent claims 3-6, 10 and 12-13, Examiner's rejection is now moot.

The Examiner next rejects claim 23 under 35 USC 103(a) as being unpatentable over Cohen '658 in view of "Brilliant Beginnings." Applicant respectfully traverses this rejection. To expedite prosecution, Applicant respectfully submits new independent claim 23 which clarifies the electronic embodiments of this invention.

#### **Commercial Success**

Applicant also asserts that the method and product described in the present application has enjoyed great commercial success, has met a long-felt need and has been met with overwhelming public approval which is commensurate in scope with the claims and due to the claimed features. In other words, as discussed with the Examiner, many books and toys exist which may help a child develop; however, the commercial success of this method and product is due to the unique activity cards as described in the presently claimed invention. Consumers in the educational and child development marketplace are free to choose on the basis of objective principles and the success is directly related to the merits of the invention.

The success includes, for example, an overwhelmingly positive response from not only the childcare community, but also from libraries, public schools, business leaders, private foundations, university faculty and parents. The Brain Box set is recognized as a unique product that can be used as a "stand alone" instructional tool or in conjunction with more formal training and instruction in early childhood brain development. Seventy-five complete sets are now in use throughout the greater Phoenix area. These sets were purchased for use in the Phoenix Public Library System, in 17 individual school districts, and in child daycare businesses. Faculty members in the Early Childhood Department at Arizona State University use the Brain Box sets

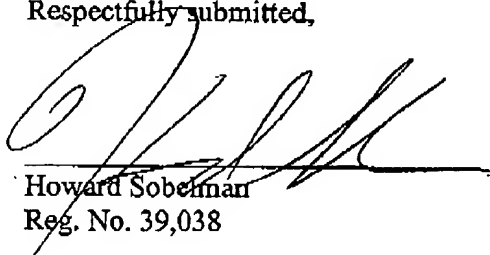
for instructional demonstration and modeling for pre-service teacher preparation classes. Applicant currently has a pending order from two large school districts for an additional 40 sets.

The feedback received from the community about the Brain Boxes is that they are a new and innovative. Applicant submits the Declarations of Dr. Jill Stamm, Debbie Pischke, Dawn Foley, Billie J. Enz, and Michelle Rhodes to further evidence the success of the presently claimed invention.

Accordingly, Applicant respectfully submits that the pending claims are in condition for allowance. No new matter is added in this Response. Reconsideration of the application is thus requested. The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. A duplicate copy of this sheet is enclosed. Applicant invites the Office to telephone the undersigned if the Examiner has any questions regarding this Response or the present application in general.

Respectfully submitted,

Dated: February 10, 2005

  
Howard Sobelman  
Reg. No. 39,038

**SNELL & WILMER L.L.P.**  
400 E. Van Buren  
One Arizona Center  
Phoenix, Arizona 85004  
Phone: 602-382-6228  
Fax: 602-382-6070  
Email: [hsobelman@swlaw.com](mailto:hsobelman@swlaw.com)